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10/738,543	12/17/2003	Torsten Gottschalk-Gaudig	WAS 0611 PUS / Wa 10239-S	8271
22045	7590	02/10/2009	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			LIGHTFOOT, ELENA TSOY	
			ART UNIT	PAPER NUMBER
			1792	
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			02/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action

The amendment filed on February 6, 2009 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on December 10, 2008.

Response to Arguments

Applicants' arguments filed February 6, 2008 have been fully considered but they are not persuasive.

Barthel

Applicants argue that the Office appears to be missing the fact that Barthel is only directed to highly, virtually completely hydrophobicized silica having a methanol number of 50 or more, preferably more. Regardless of whether one could choose a type of silylating agent, an amount of silylating agent, the silylation conditions, the silica surface area, the silica preparation method, etc., to create a partly hydrophobic silica having the claimed methanol number of less than 30, Barthel teaches not to do so, but to instead select the above variables such that a methanol number ≥ 50 is achieved. Barthel teaches away from producing silica with methanol numbers 50. Teaching away is strong evidence of non-obviousness. *W.L. Gore v. Garlock*, 220 USPQ 303 (Fed. Cir. 1983). The examples set forth in the specification are summarized in the table on the next page. These are Examples 1-5. Also in the table are additional examples and comparative examples performed under the direction of Dr. Torsten Gottschalk-Gaudig, and a Barthel example and comparative example. The Barthel requirements for his fully hydrophobicized silica.

The Examiner respectfully disagrees with this argument. Barthel uses *dimethyldichlorosilane* (See column 10, line 65) in an amount of 2-100 parts by weight per 100 parts of silica having surface area **200 m²/g**. Thus, Barthel's range 2-100 wt% overlaps claimed range 2.56-2.86 wt %. It is well settled that overlapping ranges are *prima facie* evidence of obviousness. Therefore, it would have been obvious to one having ordinary skill in the art to have selected **the portion of Barthel's range that corresponds to the claimed range**.

The Applicants' Table 1 shows that in all examples with pyrogenic silica of 200 m²/g treated with less than 2.86 wt % of DMDCS (See Examples 1 and 2), methanol number is less than 30. Therefore, Barthel's pyrogenic silica of 200 m²/g treated with less than 2.86 wt% of DMDCS should have methanol number of less than 30 not 50 as asserted by Applicants.

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Applicants did not show why Barthel' pyrogenic silica of 200 m²/g treated with less than 2.86 wt% of DMDCS should have methanol number of less than 30.

Tojo et al

As Tojo indicates at column 5, first full paragraph, when dry method silica such as fumed silica is used in his process, all the surface silanol groups are blocked. Thus, the silicas of Tojo cannot have a surface silanol content of 0.9 to 1.7 SiOH/nm² as required by the claim. Claim 15 requires that the starting silica is dry process silica.

The Examiner respectfully disagrees with this argument. Tojo uses the silylating agent in an amount varying within a wide range. Therefore, the degree of blockage would also vary within a wide range: the surface silanol groups could be fully blocked at higher end of the range, but not fully blocked at lower range.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

February 10, 2009

/Elena Tsoy Lightfoot/